

APR 12 2007 PATENT

Attorney Docket No. BOOSY-08803

**REMARKS**

Claims 1, 3-9 and 26 have been examined. In the instant Office Action, the Examiner has raised the following new rejections:

- 1) Claims 1, 4-9 and 26 stand rejected under 35 U.S.C. 103(a), as allegedly unpatentable over U.S. Patent No. 3,666,582 to Kauffman et al. (Kauffman) in view of U.S. Patent No. 3,520,055 to Jannet (Jannet); and
- 2) Claim 3 stands rejected under 35 U.S.C. 103(a), as allegedly unpatentable over U.S. Patent No. 3,666,582 to Kauffman et al. (Kauffman) in view of U.S. Patent No. 3,910,621 to Hillier (Hillier).

Applicant has amended Claim 1, and canceled Claims 8 and 9, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments. Applicant reserves the right to prosecute the original, similar, or broader claims in one or more future application(s).

**1) The Claims Are Patentable Over Kauffman and Jannet**

The Examiner has rejected Claims 1, 4-9 and 26 under 35 U.S.C. 103(a), as allegedly unpatentable over U.S. Patent No. 3,666,582 to Kauffman et al. (Kauffman) in view of U.S. Patent No. 3,520,055 to Jannet (Jannet). In particular the Examiner states that Kauffman

shows [a] vacuum table for ordering a plurality of workpieces in a particular array. The vacuum table comprises a grid of slots indicated by the framework 18. Below the grid framework is a screen comprising a plurality of holes 12 wherein the holes 12 correspond respectively to the slots of the grid. This screen is made of a rigid material. Below the screen is a vacuum tank. The grid, screen, and the tank are aligned by the permanent attachment of the grid, screen, and tank. ... Jannett teaches that a vacuum pump may be connected to the outlet of the tank of a vacuum table in order to provide negative pressure for the vacuum tank (Office Action, pages 2 and 3).

Although Applicant respectfully disagrees that the claims are obvious over the combination of Kauffman and Jannett, Applicant has amended Claim 1 and canceled Claims 8 and 9, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments, and

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while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Specifically, Applicant has amended Claim 1 to recite “wherein said screen and said grid are not integral with said tank and are configured to be removed from said open end of said tank.” Support for this amendment can be found but is not limited to Figure 1A, which illustrates that the screen and the grid are not permanently attached to the tank. Further support is found for example, in the description, which teaches that “the apparatus also comprises a tank 13, on which both the screen 12 and grid 11 are placed, either before or after the individual tile units are set in the grid” (Specification, page 8, lines 3 and 4). Importantly, the use of separable screen and grid components permits the use of a design template, which is temporarily positioned under the grid for ordering colored or textured tiles for intricate designs (Specification, paragraph bridging pages 8 and 9, and page 9, lines 10-12).

As acknowledged by the Examiner, Kauffman teaches the *permanent attachment* of the grid, screen and tank elements of the template 2. Importantly, *integral* grid, screen and tank elements are required for the template to perform as intended by Kauffman. As shown in Figures I, IV and VI, the template of Kauffman is configured to move horizontally and vertically about axes x and y, and to rotate 180° about axis z. This movement would serve to dislodge the screen, grid and/or tiles within the template if the tank, screen and grid were not integral. Thus, modification of the template of Kauffman to include separable tank, screen and grid elements would render the template of Kauffman unsatisfactory for its intended purpose. Per MPEP 2143.01V, if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” As such, there is no motivation to modify Kauffman to arrive at the apparatus of the amended claims comprising a screen and grid configured to be removed from a tank. Since Jannett does not remedy the deficiencies of Kauffman, the amended claims are patentable over this combination of references and Applicant respectfully requests that this rejection be withdrawn.

**PATENT**Attorney Docket No. **BOOSY-08803****2) The Claims Are Patentable Over Kauffman , Jannett and Hillier**

The Examiner has rejected Claim 3 under 35 U.S.C. 103(a), as allegedly unpatentable over Kauffman and Jannett, in view of U.S. Patent No. 3,910,621 to Hillier (Hillier). The Examiner states: "Hillier teaches that a custom plate 14 can be used to plug selective holes of the vacuum screen," and to employ a custom plate in an apparatus derived from the combination of Kauffman and Jannett would be obvious to one of skill in the art (Office Action, page 3). Even so, this rejection is moot as the primary references of Kauffman and Jannett do not teach or suggest elements of the independent claim as detailed above, and because Hillier does not remedy these deficiencies. Since the amended claims are not obvious in view of Kauffman, Jannett and Hillier, Applicant respectfully requests that this rejection be withdrawn.

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APR 12 2007****CONCLUSION**

Applicant believes the arguments and evidence provided herein traverse the Examiner's rejection and, therefore requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

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